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Date of Deposit: January 5, 2005

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Dated: January 5, 2005

By: Cindy Wilson
Cindy Wilson

PATENT
Attorney Docket No. P-090-US1
Customer Number 27038

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

)

Martin S. Linsell

)

Patent No. US 6,831,150 B2

)

Application No.: 09/847,060

)

Issued: December 14, 2004

)

Filed: May 1, 2001

)

Group Art Unit: 1653

)

For: REDUCTIVE ALKYLATION
PROCESS

)

Examiner: Anand U. Desai

)

01/07/2005 MBYEENE2 00000158 500344 09847060

01 FC:1455 200.00 DA

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
INDICATED IN PATENT (37 C.F.R. § 1.705)**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests reconsideration of the patent term adjustment indicated on U.S. Patent No. 6,831,150 B2, issued on December 14, 2004. This paper is being filed within two months of the issue date of this patent, i.e., on or before February 14, 2005.

A previous "Request for Reconsideration of Patent Term Adjustment Indicated in Notice of Allowance (37 C.F.R. § 1.705)" was filed for this application on April 20, 2004. In that request, Applicant requested reconsideration solely on the basis that the Office had failed to issue a patent within 3 years of the actual filing date of the application. In response to the previous

request, the Office indicated that a decision on the request for reconsideration of the patent term adjustment would be held in abeyance until after the actual patent date (copy of communication enclosed). Applicant was given two (2) months from the issue date to file a written request for reconsideration of the patent term adjustment. Now that the patent has issued, Applicant respectfully requests reconsideration of the patent term adjustment indicated on the issued patent for the following reasons.

1. Statement of Facts

Pursuant to 37 C.F.R. §1.705(b)(2), Applicant respectfully submits the following statement of the facts involved:

A. 37 C.F.R. § 1.705(b)(2)(i) and (ii)

The patent term adjustment shown on the patent is 454 days. Applicant respectfully submits that the patent is entitled to an additional 120 days of patent term adjustment under 37 C.F.R. § 1.702 (a) because the Office erroneously deducted 120 days for a paper submitted after Notice of Allowance. Accordingly, the correct patent term adjustment under §1.702 is 574 days.

The basis on which Applicant seeks adjustment is as follows:

(a) Period of Adjustment Pursuant to 37 C.F.R. §§1.702(a) and 1.703(a)

Pursuant to 37 C.F.R. § 1.702(a)(1), the USPTO failed to mail at least one of a notification under 35 U.S.C. §132 or a notice of allowance under 35 U.S.C. §151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. §111(a). Specifically, the date of filing for this application is May 1, 2001; and the USPTO issued a first Office Action on October 2, 2003, resulting in 458 days of USPTO delay.

Additional, pursuant to 37 C.F.R. § 1.702(a)(4), the USPTO failed to issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. §151 and all outstanding requirements were satisfied. Specifically, the issue fee was paid on April 20, 2004, and the patent issued on December 14, 2004, resulting in 116 days of USPTO delay.

Accordingly, under 37 C.F.R. § 1.702(a), Applicant is entitled to 574 days of patent term adjustment (458 days + 120 day = 574 days).

(b) Reduction in Period of Adjustment Pursuant to 37 C.F.R. §1.704

Pursuant to 37 C.F.R. § 1.704(b)(10), the USPTO reduced the patent term adjustment for this patent by 120 days based on a paper being submitted by Applicant after the Notice of Allowance was mailed. However, the paper submitted by Applicant was a replacement (duplicate) copy of a paper previously submitted and apparently lost by the USPTO. This paper was submitted in response to a specific request made by the Examiner.

Specifically, Applicant submitted an Information Disclosure Statement (IDS) for this application on February 12, 2002. The Notice of Allowance was mailed on February 6, 2004. On February 26, 2004, the Examiner requested by telephone that Applicant submit a replacement copy of the IDS. Applicant submitted the replacement copy on February 26, 2004 (copy of communication attached without cited documents). As a result of the submission of the paper, the USPTO erroneously deducted four months (120 days) of patent term adjustment pursuant to 37 C.F.R. § 1.704(b)(10)(ii).

However, since the Examiner specifically requested that this replacement copy be submitted after mailing of the Notice of Allowance, the submission of this paper is not a circumstance that constitutes a failure of the Applicant to engage in reasonable efforts to conclude processing or examination of this application under 37 C.F.R. §1.704. Accordingly, Applicant respectfully requests reconsideration of this reduction in patent term adjustment and respectfully request that the term be corrected to 574 days.

B. 37 C.F.R. §1.705(b)(2)(iii)

This patent is not subject to a terminal disclaimer.

C. 37 C.F.R. §1.705(b)(2)(iv)

Applicant is not aware of any circumstances during the prosecution of this application that constitute a failure to engage in reasonable efforts to conclude processing or examination of this application as set forth in 37 C.F.R. §1.704.

D. Summary

Applicant respectfully requests that the patent term adjustment for this patent be corrected to 574 days.

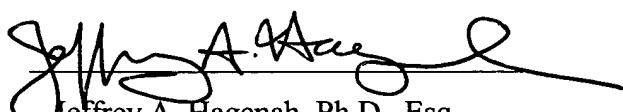
2. Fee Pursuant to 37 C.F.R. §1.18(e)

In the USPTO response to the first “Request for Reconsideration of Patent Term Adjustment” submitted for this application, the Office acknowledged payment of the \$200.00 fee set forth in 37 C.F.R. §1.18(e), and indicated that no additional fees would be required for reconsideration after issuance of the patent. Accordingly, no fee is due for submission of this paper. However, in the event that any fees are deemed due, the Commissioner is authorized to charge any such fees or credit any overpayment to Deposit Account 50-0344.

Should there be any questions concerning this paper, please contact the undersigned attorney at (650) 808-6406.

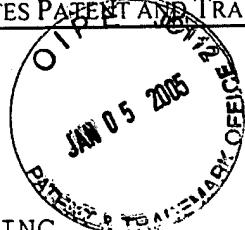
Respectfully submitted,

Date: January 5, 2005
THERAVANCE, INC.
901 Gateway Boulevard
South San Francisco, CA 94080
Tel: (650) 808-6000 Fax: (650) 808-6078


Jeffrey A. Hagenah, Ph.D., Esq.
Reg. No. 35,175



UNITED STATES PATENT AND TRADEMARK OFFICE



COPY

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

THERAVANCE, INC.
901 GATEWAY BOULEVARD
SOUTH SAN FRANCISCO, CA 94080

RECEIVED	
AUG 16 2004	
THERAVANCE, INC. LEGAL DEPARTMENT	

COPY MAILED
AUG 10 2004
OFFICE OF PETITIONS

In re Application of :
Martin Linsell : ON REQUEST FOR
Application No. 09/847,060 : RECONSIDERATION OF
Filed: May 1, 2001 : PATENT TERM ADJUSTMENT
Attorney Docket No. P-090-R :
:

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705)," filed April 20, 2004. Applicant requests that the patent term adjustment be corrected from four hundred fifty-eight (458) days to five hundred sixty-six (566) days. Applicant requests reconsideration solely on the basis that the Office has failed to issue a patent within 3 years of the actual filing date of the application.

A decision on the request for reconsideration of the patent term adjustment indicated in the patent is being held in abeyance until after the actual patent date.

Applicant is given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment indicated in the patent on this basis. Applicants may seek such reconsideration without payment of an additional fee.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (703) 305-0309.

Karin Ferriter

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

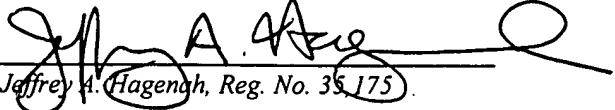
*Request for reconsideration
of Patent Term Adjustment
due 2/14/05*



CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (703) 872-9306, on the date shown below:

Dated: 2/26/04

By: 

Jeffrey A. Hagenah, Reg. No. 35,175

Patent
Attorney's Docket No. P-090-US1
Customer Number: 27038

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Martin S. Linsell) Group Art Unit: 1653
Application No.: 09/847,060) Examiner: Anand U. Desai
Filed: May 1, 2001) Confirmation No. 4580
For: REDUCTIVE ALKYLATION)
PROCESS)

COPY

COMMUNICATION AFTER NOTICE OF ALLOWANCE

(No Reduction of Period of Adjustment of Patent Term Under 37 C.F.R. §1.704)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner request by telephone on February 26, 2004, enclosed is a replacement copy of the Information Disclosure Statement (IDS) submitted previously by Applicants on February 12, 2002, for the above-identified patent application. A Notice of Allowance for this application was mailed on February 6, 2004, and the issue fee has not yet been paid.

The attached replacement copy is a complete and accurate copy of the IDS submitted previously on February 12, 2002, as evidenced by the return postcard stamped by the USPTO acknowledging receipt thereof.

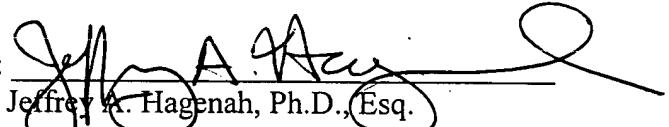
Since this replacement copy of the IDS was requested by the Examiner, this communication is not a circumstance that constitutes a failure of the applicant to engage in reasonable efforts to conclude processing or examination of this application under 37 C.F.R. §1.704.

Should there be any questions regarding this communication, the Examiner is encouraged to telephone the undersigned attorney for Applicants at (650) 808-6406.

Respectfully submitted,
THERAVANCE, INC.

Date: February 26, 2004

By:


Jeffrey A. Hagenah, Ph.D., Esq.
Reg. No. 35,175

THERAVANCE, INC.
901 Gateway Blvd.
South San Francisco, CA 94080
(650) 808-6000
(650) 808-6078 (Fax)

In re Patent Application of: Martin S. Linsell

Title: REDUCTIVE ALKYLATION PROCESS

Serial No.: 09/847,050

Filing Date: May 1, 2001

Receipt is hereby acknowledged for the following in the United States Patent and Trademark Office:

CONTENTS: a Supplemental Information Disclosure Statement (1 pgs.), Form 1449 (1 pgs.), and copies of 2 cited references; PCT Search Report (4 pgs.); a Return Postcard and TRANSMITTAL SHEET.

Mailed: January 17, 2002

RJH/agd

Docket No.: 1343.004US1

Due Date: N/A



COPY



COPY

In re Patent Application of: Martin S. Linsell
Title: REDUCTIVE ALKYLATION PROCESS
Serial No.: 09/847,060

Filing Date: May 1, 2001

Receipt is hereby acknowledged for the following in the United States Patent and Trademark Office:

CONTENTS: a Supplemental Information Disclosure Statement (1 pgs.), Form 1449 (1 pgs.), and copies of 2 cited references; PCT Search Report (4 pgs.); a Return Postcard and TRANSMITTAL SHEET.

Mailed: January 17, 2002
RJH/agd

Docket No.: 1343.004US1
Due Date: N/A

AM1-090-R



COPY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Martin S. Linsell

Title: REDUCTIVE ALKYLATION PROCESS

Docket No.: 1343.004US1

Serial No.: 09/847,060

Filed: May 1, 2001

Due Date: N/A

Examiner: Unknown

Group Art Unit: Unknown

Commissioner for Patents
Washington, D.C. 20231

We are transmitting herewith the following attached items (as indicated with an "X"):

A return postcard.
 A Supplemental Information Disclosure Statement (1 pgs.), Form 1449 (1 pgs.), and copies of 2 cited references.
 PCT Search Report (4 pgs.).

Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers and please charge any additional required fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938, Minneapolis, MN 55402 (612-373-6900)

By:
Atty: Robert J. Harris, Ph.D.
Reg. No. 37,346

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on this 17th day of January, 2002.

Name Allisia G. Dunbar

Signature

Customer Number 21186

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938, Minneapolis, MN 55402 (612-373-6900)
(GENERAL)

S/N 09/847,060

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Martin S. Linsell
Serial No.: 09/847,060
Filed: May 1, 2001
Title: REDUCTIVE ALKYLATION PROCESS

Examiner: Unknown
Group Art Unit: Unknown
Docket: 1343.004US1

JAN 05 2005
U.S. PATENT & TRADEMARK OFFICE

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

In compliance with the duty imposed by 37 C.F.R. § 1.56, and in accordance with 37 C.F.R. §§ 1.97 *et seq.*, the enclosed materials are brought to the attention of the Examiner for consideration in connection with the above-identified patent application. Applicant respectfully requests that this Information Disclosure Statement be entered and the documents listed on the attached Form 1449 be considered by the Examiner and made of record. Pursuant to the provisions of MPEP 609, Applicant further request that a copy of the 1449 form, initialed by the Examiner to indicate that all listed citations have been considered, be returned with the next official communication.

Under 37 C.F.R. § 1.97(b)(3), it is believed that no fee or certificate is required with this Information Disclosure Statement. However, if an Office Action on the merits has been mailed the undersigned attorney hereby certifies under 37 C.F.R. § 1.97(e)(1) that each item of information contained in this Supplemental Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement. Enclosed for the Examiner's information is a copy of the documents and the International Search Report.

The Examiner is invited to contact the Applicant's Representatives at the below-listed telephone number if there are any questions regarding this communication.

Respectfully submitted,

MARTIN S. LINSELL

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 359-3265

Date

1-17-02

By



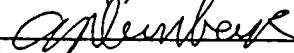
Robert J. Harris, Ph.D.
Reg. No. 37,346

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 17th day of January, 2002.

Name

Alisia G. Dunbar

Signature



COPY

Sheet 1 of 1

Form 1449*	Atty. Docket No.: 1343.004US1	Serial No. 09/847,060
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary)	Applicant: Martin S. Linsell	
	Filing Date: May 1, 2001	Group: Unknown

U. S. PATENT DOCUMENTS

**Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date If Appropriate
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FOREIGN PATENT DOCUMENTS

**Examiner Initial	Document Number	Date	Country	Class	Subclass	Translation Yes No
	0201251	12/17/1986	European	C07K	9/00	
	0873997	10/28/1998	European	C07K	9/00	

OTHER DOCUMENTS

**Examiner Initial	(Including Author, Title, Date, Pertinent Pages, Etc.)		
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Examiner	Date Considered
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*Substitute Disclosure Statement Form (PTO-1449)

**EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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